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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,895	12/30/2005	Alain Bejean	94176	9332
24628 7590 07/28/2010 Husch Blackwell Sanders, LLP Husch Blackwell Sanders LLP Welsh & Katz 120 S RIVERSIDE PLAZA 22ND FLOOR CHICAGO, IL 60606				
EXAMINER				
HENNING, MATTHEW T				
ART UNIT		PAPER NUMBER		
2431				
MAIL DATE		DELIVERY MODE		
07/28/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/532,895

**Applicant(s)**

BEJEAN, ALAIN

**Examiner**

MATTHEW T. HENNING

**Art Unit**

2431

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-11 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1                   This action is in response to the communication filed on 2/9/2010.

2                   **DETAILED ACTION**

3                   ***Continued Examination Under 37 CFR 1.114***

4                   A request for continued examination under 37 CFR 1.114, including the fee set forth in  
5   37 CFR 1.17(e), was filed in this application after final rejection. Since this application is  
6   eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)  
7   has been timely paid, the finality of the previous Office action has been withdrawn pursuant to  
8   37 CFR 1.114. Applicant's submission filed on 2/9/2010 has been entered.

9  
10                  ***Response to Arguments***

11                 Applicant's arguments filed 2/9/2010 have been fully considered but they are not  
12   persuasive.

13                 First, applicant's arguments with respect to claims 13 and 2-7 are moot in view of the new  
14   grounds of rejection presented below.

15                 Regarding claims 8-11, the examiner notes that claim 8 as written is treated as an  
16   independent claim. As such, the intended use recited in the preamble of the system claim has not  
17   been given patentable weight because the limitation of the body of the claim can stand alone.  
18   Therefore, the applicants' arguments are not found persuasive.

19                 All objections and rejections not set forth have been withdrawn.

20                 Claims 2-11 and 13 have been examined.  
21  
22

***Information Disclosure Statement***

The information disclosure statement(s) (IDS) submitted on 2/9/2010 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statements.

***Priority***

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 13 and 2-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Domenz et al. (US Patent Application Publication Number 2004/0177279), hereinafter referred to as Domenz.

A method of securing a learning mode of a device, the device including a secure first command transmitter and a command receiver, the command receiver being capable of driving an element providing for at least one of the security and the comfort of occupants of a building, the method comprising: providing at least one first activation function for switching the command receiver to the learning mode, the first activation function being associated with the

secure first command transmitter; providing at least one second activation function for switching the command receiver to the learning mode, the second activation function being associated with at least one of the command receiver, a second command transmitter, and a main power supply; applying at least one action to the secure first command transmitter; the application of the at least one action to the secure first command transmitter causing a disabling of the second activation function for switching the command receiver to the learning mode; the disabling of the second activation function preventing the command receiver from being switched to the learning mode by the second activation function; and maintaining a capability of the secure first command transmitter to switch the command receiver to the learning mode via the first activation function after the disabling of the second activation function (Domenz Figs. 3-4 and Paragraph 0005).

Regarding claim 2, Domenz taught wherein the at least one action comprises at least a first action that is undertook on at least one secure command transmitter and successively or simultaneously at least a second action that is undertook on at least one other command transmitter (Domenz Paragraph 0005).

Regarding claim 3, Domenz disclosed wherein the at least one action on the secure command transmitter activates the learning mode of the receiver (Domenz Paragraph 0005).

Regarding claim 4, Domenz disclosed wherein the at least one action on the secure command transmitter disables the at least one activation function of the learning mode with the exception of the at least one activation function of the secure command transmitters (Domenz Paragraph 0005).

Regarding claim 5, Domenz disclosed wherein the disabling of the activation function is irreversible (Domenz Paragraph 0005).

Regarding claim 6, Domenz disclosed wherein the disabling of the activation function is temporary (Domenz Paragraph 0005).

Regarding claim 7, Domenz disclosed wherein an action on a secure command transmitter causes, in the memory of the receiver, the erasure of the identity numbers of at least certain transmitters (Domenz Paragraph 0022).

Claims 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Heitschel et al. (US Patent Number Re. 35,364) hereinafter referred to as Heitschel.

Regarding claim 8, Heitschel taught a device intended to implement the method as claimed in claim 13, which device comprises at least one secure command transmitter (master transmitter), and possibly other command transmitters, communicating with a command receiver capable of driving an element providing for the security and/or the comfort of a building (Heitschel Col. 3 Line 60 – Col. 4 Line 22).

Regarding claim 9, Heitschel taught that the secure command transmitters comprise wireless means of remote communication with the command receiver (Heitschel Col. 3 Line 60 – Col. 4 Line 22).

Regarding claims 10-11, Heitschel taught that the secure command transmitters have two dimensions small enough so that the secure command transmitters are capable of being stored in a strongbox (Heitschel Fig. 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

Claims 2-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over, and further in view of Bruwer (US Patent Number 6,191,701).

Regarding claim 12, Heitschel disclosed a method of securing the learning mode of a device (receiver), the device including an assembly of at least one command transmitter (transmitter) communicating with a command receiver, the command receiver capable of being switched to a learning mode by at least one activation function and the command receiver capable of driving an element providing for the security and/or the comfort of a building (Heitschel Abstract and Col. 3 Lines 41-59), the method comprising: applying at least one action to a device of the assembly (Heitschel Col. 3 Lines 41-59 Switching to the Operate Position on the receiver); but Heitschel did not disclose that the “action” was applied to a particular command transmitter of the assembly in order to disable the learning mode, or preventing the command receiver from being switched into the learning mode by the disabled activation function.

Bruwer, on the other hand, teaches that in order to improve the security of a programmable receiver (decoder), instead of activating the learning mode on the receiver, a

1 master transmitter (master encoder) can be used to set the learning mode on the receiver (Bruwer  
2 Col. 7 Line 62 – Col. 8 Line 5), and after the learning mode is complete the master transmitter is  
3 set back to normal mode, and subsequently the receiver is set to normal mode (Bruwer Col. 8  
4 Line 55-63). Bruwer further teaches that the master transmitter learning mode can be disabled in  
5 order to prevent the learning mode from being activated using the master transmitter (Bruwer  
6 Col. 17 Line 45 – Col. 18 Line 4).

7 It would have been obvious to the ordinary person skilled in the art at the time of  
8 invention to have employed the teachings of Bruwer in the garage door opener system of  
9 Heitschel by providing a master transmitter which is used to switch between the operating mode  
10 and the programming mode, and further providing that the learning mode of the master  
11 transmitter be disabled after programming the receiver. This would have been obvious because  
12 the ordinary person skilled in the art would have been motivated to improve the security of the  
13 coding system.

14 Regarding claim 2, Heitschel and Bruwer taught that the at least one action comprises at  
15 least a first action that is undertaken on at least one secure command transmitter and successively  
16 or simultaneously at least a second action that is undertaken on at least one other command  
17 transmitter (See Bruwer Col. 7 Line 62 – Col. 8 Line 5 and Heitschel Col. 3 Line 60 – Col. 4  
18 Line 22).

19 Regarding claim 3, Heitschel and Bruwer taught that the at least one action on the secure  
20 command transmitter activate the learning mode of the receiver (Bruwer Col. 7 Line 62 – Col. 8  
21 Line 5).



Regarding claim 4, Heitschel and Bruwer taught that the at least one action on the secure command transmitter disables the at least one activation function of the learning mode with the exception of the at least one activation function of the secure command transmitters (See Bruwer Col. 7 Line 62 – Col. 8 Line 5 and Heitschel Col. 3 Line 60 – Col. 4 Line 22).

Regarding claim 5, Heitschel and Bruwer taught that the disabling of the activation function is irreversible (Bruwer Col. 7 Line 62 – Col. 8 Line 5).

Regarding claim 6, Heitschel and Bruwer taught that the disabling of the activation function is temporary (Heitschel Col. 3 Line 60 - Col. 4 Line 22).

Regarding claim 7, Heitschel and Bruwer taught that an action on a secure command transmitter causes, in the memory of the receiver, the erasure of the identity numbers of at least certain transmitters (Heitschel Col. 5 Lines 3-5).

### ***Conclusion***

Claims 2-11 and 13 have been rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW T. HENNING whose telephone number is (571)272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571)272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew T Henning/  
Primary Examiner, Art Unit 2431